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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/485,845	04/26/00	FUNAMIZU	H 2554-7

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HM12/0329

EXAMINER

COLEMAN, B

ART UNIT	PAPER NUMBER
1624	

DATE MAILED:

03/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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<b>Office Action Summary</b>	Application No. <b>09/485,845</b>	Applicant(s) <b>FUNAMIZU et al.</b>
	Examiner <b>Brenda Coleman</b>	Group Art Unit <b>1624</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-32 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-32 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1624

## **DETAILED ACTION**

Claims 1-32 are pending in the application.

### ***Election/Restriction***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-25, drawn to compounds, compositions, **a** process of preparing and a method of use where A is benzothiazepine, benzoxazepine or dibenzoxazepine.
- II. Claims 1-25, drawn to compounds, compositions, **a** process of preparing and a method of use where A is benzoazepine, benzoxazepine or dibenzoxazepine.
- III. Claims 1-25, drawn to compounds, compositions, **a** process of preparing and a method of use where A is pyrrolobenzodiazepine.
- IV. Claims 1-25, drawn to compounds, compositions, **a** process of preparing and a method of use where A is benzodiazepine.
- V. Claims 1-25, drawn to compounds, compositions, **a** process of preparing and a method of use where A is indole.
- VI. Claims 1-25, drawn to compounds, compositions, **a** process of preparing and a method of use where A is phenothiazine.

Art Unit: 1624

- VII. Claims 1-25, drawn to compounds, compositions, **a** process of preparing and a method of use where A is quinoline.
- VIII. Claims 1-25, drawn to compounds, compositions, **a** process of preparing and a method of use where A is benzothiazine, benzoxazine or pyridoxazine.
- IX. Claims 1-25, drawn to compounds, compositions, **a** process of preparing and a method of use where A is dibenzoazocine or benzoazocine.
- X. Claims 1-25, drawn to compounds, compositions, **a** process of preparing and a method of use where A is other than those defined in Groups I-XIV.
- XI. Claim 26, drawn to **a** process of preparing compounds of formula (I).
- XII. Claim 27, drawn to **a** process of preparing compounds of formula (I).
- XIII. Claim 28, drawn to **a** process of preparing compounds of formula (I).
- XIV. Claims 29-30, drawn to intermediate compounds.
- XV. Claims 31-32, drawn to intermediate compounds.

The inventions listed as Groups I-XV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I-X are different significantly in chemical structures. They are consequently separately classified in the U.S. Patent Classification System and require separate searches in the Chemical literature. None of the prior art consider these groups as functional equivalents. Each group can support a patent.

Art Unit: 1624

Inventions I-X and XI-XIII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the process of preparing the compounds of Groups I-XIV and XVI can be prepared by various methods as is evident in the applicants own disclosure. (See pages 21-26 of the specification).

Inventions I-X and XIV-XV are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful in preparation of final products of the invention and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1624

If Groups X, XI, XII, XIII, XIV or XV are elected further restriction to a particular core and/or election of species would be required by the examiner.

Tentative election of a single species within the elected group is further required.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Monday thru Friday from 9:00 AM to 5:30 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

*Brenda Coleman*  
Brenda Coleman  
March 26, 2001